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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,414	04/05/2001	Hans Josef Rinninger	31530-171041	5027

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EXAMINER

ADDIE, RAYMOND W

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,414

Applicant(s)

RINNINGER, HANS JOSEF

Examiner

Raymond W. Addie

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 12-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 12-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. In view of the supplemental appeal brief filed on 6/16/04, PROSECUTION IS HEREBY REOPENED. A New Grounds of Rejection has been set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Note to Appellant:

Should the Appellant wish to reinstate the appeal the following defects should be corrected.

Appellant has not grouped claims 5, 6, 12, 13, 18, 19, 22, 23. Hence, it is unclear as to whether Appellant does not understand the requirements of filing an Appeal Brief, or if Appellant indirectly admits that claims 6, 12, 13, 18, 19, 22, 23 lack patentable features or issues.

Further, Appellant has separately argued claims 3, 5, 6, 12, 13, 23 are separately argued, even though these claims are not grouped.

Still further although claims 3, 16 are not grouped, they are separately argued as "allowable....as being dependent upon claims 1 and 14 respectively".

It is unclear as to whether Appellant is attempting to state the claims 3, 16 stand and fall together with claims 1 and 16 respectively, or if Appellant is admitting that claims 3 and 16 lack patentable features or issues.

When claims are grouped as standing or falling together, then only 1 claim, should be argued, such that the remaining claims in the group stand or fall with the arguments directed to the one claim.

Finally should Appellant request reinstatement of the Appeal a copy of the claims should be included in any future filed brief.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-8, 12-23 are rejected under 35 U.S.C. 101 as claiming the same invention as that of prior U.S. Patent No. D448,092 S. This is a double patenting rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5-8, 12-15, 18-23 are rejected under 35 U.S.C. 103(a) as being

unpatentable over McClintock # 957,985 in view of Rinninger # 4,792,257.

McClintock discloses a concrete, cube-shaped paving stone (c) with sharp edged corners. Each face of said paving stone being planar such that the distances between the planar sides are equal and that each side of said paving stone can be used as the upper surface of the paving stone.

What McClintock does not disclose is a paving stone having a rounded portion.

However, Rinninger '257 teaches it is desirable to provide paving stones having planar sides, tops and bottoms; with clothodial rounded portions(31) that extend over $\frac{1}{4}$ - $\frac{1}{6}$ th of at least one face; in order to improve water "flow-off" from the top surface of the stone. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide the cube shaped paving stone of McClintock, with at least one clothodially rounded edge, in order to improve water drainage of the pavement formed by the paving stones.

In regards to Claims 13, 23 McClintock specifically discloses the desirable advantages to randomly spreading, leveling and grading the paving stones, to provide an aesthetically pleasing appearance and a strong, flat wearing surface provided by the paving stones. Rinninger teaches it is desirable to provide cuboidal paving stones with clothodially rounded edges, to at least a few of the paving stone faces, to permit surface water drainage, which inherently increases the safety of the paved surface, during rainfall. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to form the paved surface of McClintock, such that the paving stones are arranged in a random order, which permits at least a few of the paving stones to form drainage passages, as taught by Rinninger in order to increase the safety of the roadway.

4. Claims 3, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClintock # 957,985 in view of Rinninger # 4,792,257 as applied to claims 1, 14 above, and further in view of Scheiwiller # 5,348,417.

McClintock in view of Rinninger disclose using plurality of differently sized paving stones, in order to form a composite paving surface, having a varied and non-monotonous appearance. What McClintock in view of Rinninger does not disclose is the specific combination of paving stones to include additional blocks that are twice the length and/or twice the width of the standard cuboid stone.

However, Scheiwiller discloses a set of paving stones (1, 7), comprising a 1st molded block (10) having a square cross section, in plan view, and a 2nd molded block (7) having an oblong/rectangular cross section in plan view; with a width and height of edge dimension L equal to that of the 1st molded block and a length of edge dimension 2L. Said set of paving stones (1, 7) can be combine in various patterns to form an appealing surface. See col. 1, ln. 49-col. 2, ln. 31.

5. Claims 3, 4, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClintock # 957,985 in view of Rinninger # 4,792,257 as applied to claims 1, 14 above, and further in view of Scheiwiller # 5,503,498.

McClintock in view of Rinninger disclose using plurality of differently sized paving stones, in order to form a composite paving surface, having a varied and non-monotonous appearance.

What McClintock in view of Rinninger does not disclose is the specific combination of paving stones to include additional stones having an oblong/rectangular cross section in plan view; with a width and height of edge dimension L equal to that of the 1st molded block and a length of edge dimension $2L$; nor the use of additional blocks that are square in plan view and with dimensions of four cubes with the size of 4 cubes lying beside one another.

However, Scheiwiller discloses a set of paving stones (33, 34, 35), comprising a 1st molded block (1) having a square cross section, in plan view, and a 2nd molded block (34) having an oblong/rectangular cross section in plan view; with a width and height of edge dimension L equal to that of the 1st molded block and a length of edge dimension $2L$ and a 3rd paving stone (35) having the size of 4 standard stones (33) Said set of paving stones (1, 7) can be combine in various patterns to form an appealing surface.

See Fig. 8; col. 7, Ins. 14-23. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide the paving stones of McClintock in view of Rinninger in a set of paving stones having a variety of sizes and shapes, as taught by Scheiwiller '498, in order to provide a paved surface having a varied appearance. See Scheiwiller '498 col. 2, Ins 62-68.

Response to Arguments

6. Applicant's arguments filed 6/16/04 have been fully considered but they are not persuasive.

Appellant argues against the combination of McClintock in view of Rinninger, by stating " The resulting paving stones will have a haphazard orientation relative to one another, and there is no intent in McClintock for the two-inch cubic paving material to provide an improved or ornamental appearance".

However, none of the claims require an improved or ornamental appearance. Hence, the argument is not persuasive and the rejection is maintained.

Appellant then argues "Rinninger '257 patent are for garden walkways (column 1, lines 6-8). Providing a natural appearance is of no concern in the McClintock patent, and a person with ordinary skill in the art would have seen no need for the cubes to be modified so that they provide a more natural appearance. Furthermore, the pitch, pout, cement, mortar or other material filling the spaces between the cubes of McClintock is likely to at least partially cover any rounded comers that might be put on the cubes and, thus, defeat the purpose of achieving a natural appearance like that achieved in the Rinninger '257 patent".

However, the Examiner does not concur. As put forth above, and in the Last Office Action the teachings of Rinninger were combined with the disclosure of

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McClintock in order to increase safety by providing drainage openings to drain surface water from the paved surface, and not for aesthetic purposes, as argued.

Therefore, the argument is not persuasive and the rejection is maintained.

Appellant then argues " Furthermore, even though Rinninger '257 discloses rounded portions extending as much as $1/6$ of the paving stone face on which the rounded portion is formed, there would have been no incentive for one of ordinary skill in the art to place on the 2-inch blocks of McClintock rounded corners that extend over at least $1/6$ of their faces. The fact that the corners of the McClintock blocks could have been made that way does not mean that it would have been obvious to do so.

However, the Examiner does not concur. As put forth in the Last Office Action, Rinninger teaches, in regards to Claim 1, that it is desirable to provide paving stones having planar sides, tops and bottoms; with clothodially rounded portions (31) that extend over $1/4$ - $1/6^{\text{th}}$ of at least one face; in order to improve water "flow-off" from the top surface of the stone.

And not for aesthetic purposes as argued by Appellant.

Applicant further argues "Moreover, Claim 1 calls for at least a first one of the faces of the molded block being substantially planar over substantially its entire surface area.

Two such faces of the molded block according to the present invention are the face 2 on the top of the block as shown in Fig. 1a and face 2 shown at the right front in Fig. 1b.

In contrast, the Rinninger '257 patent discloses no face that is substantially planar over substantially its entire surface area. For example, the plan view of Fig. 2a of Rinninger shows that the top, bottom, left and right faces of that figure all have at least one rounded portion that keeps it from being substantially planar. With respect to the surface shown in plan in Fig. 2a, it can be seen that the corner regions 28-30 each define a clothoid (column 5, lines 20-22), thereby preventing the surface at the top of Fig. 2b and shown in plan in Fig. 1b from being a face that is substantially planar over substantially its entire surface area".

However, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case it is the primary reference to McClintock that teaches a paving stone having approximately the shape of a cube, each face being substantially planar. Further, Rinninger teaches it is desirable to provide a paving stone with clothodial rounded portions (31) that extend over $\frac{1}{4}$ - $\frac{1}{6}$ th of at least one face; in order to improve water "flow-off" from the top surface of the stone.

Therefore, the argument is not persuasive and the rejection is maintained.

Appellant then argues "Claim 5 depends on Claim 1 and calls for the radius of curvature of the rounded portion to decrease constantly toward the side edge. Similarly, Claim 18 depends on Claim 14 and calls for the radius of curvature of the rounded portion to decrease constantly toward the side edge. Using the rationale presented above in connection with claims 1 and 14 concerning the unobviousness of placing rounded portions on the two-inch cubes of McClintock, it would have been even more unobvious to make rounded portions having a radius of curvature which decreases constantly toward the side edge. Similarly, with respect to Claims 6 and 19, it would have been even less obvious to form the two-inch cubes of McClintock with a clothoid extending toward the side edge over approximately $1/4$ to $1/6$ of the cube length.

However, the Examiner does not concur. McClintock discloses the usefulness of forming a roadway using paving stones having approximately the shape of a cube. Rinninger teaches it is desirable provide a paving stone with clothodial rounded portions (31) that extend over $1/4$ - $1/6^{\text{th}}$ of at least one face; in order to improve water "flow-off" from the top surface of the stone.

Therefore, the argument is not persuasive and the rejection is maintained.

Applicant then argues " To have modified the two-inch blocks of McClintock to include clothoid corners at just enough corners to lead to substantially planar faces opposite one another would have been an improper picking and choosing of certain features from a modifying reference while leaving others behind. Such a modification would not have been obvious.

However, the Examiner does not concur.

Claim 1 only requires "each face of said molded block having at least a portion which is planar...at least a first one of the faces of said molded block being substantially planar over substantially its entire surface area, at least a 2nd one of said faces having at least one rounded portion extending toward one side edge of said molded block over at least 1/6 of said at least one face".

Hence, claim 1 permits more embodiments than what is argued. Therefore, the argument is not persuasive and the rejection is maintained.

Appellant then argues "For the reasons presented above in connection with Claims 1 and 14, it would not have been obvious to provide on some of the blocks of McClintock et al., as the upper faces of laid blocks in a pattern, faces that are substantially planar over their entire surface areas. Furthermore, even if some of the blocks of McClintock et al. had one or more faces that were substantially planar over their entire surface areas, it would be a matter of chance whether such faces ended up facing upward after the blocks were dumped from a cart, spread out, and then raked together".

However, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case McClintock explicitly discloses a laid set of blocks comprising molded blocks laid adjacent one another in a pattern, wherein the upper surface of each of the blocks of said set is at the same height. Further, Rinninger teaches it is desirable to provide a paving stone with rounded edges to improve water drainage. Hence, the manner in which McClintock disposes the paving stones onto a roadway, may in fact be arbitrary, but would certainly in a self-evident manner provide some paving stones to be laid planar side up and some paving stone to be laid rounded surface up; which meets the limitations in the argued claims.

Therefore, the argument is not persuasive and the rejection is maintained.

Appellant further argues, with respect to Claims 3, 16 " McClintock further states that the form of the cubes ensures that they will always rest upon their bases (page 1, lines 44-46). Thus, according to McClintock's invention, when his two-inch blocks are spread out and raked together, they will rest on their bases, as close together as possible, and thereby form a smooth upper surface. Making some of the two-inch cubes twice the

length and/or twice the width of the other cubes would have had the result of making it more difficult to rake together the small blocks in a closely packed arrangement, and would have increased the likelihood that some of the larger blocks would protrude upward from the surface defined by the other blocks, and thereby make the surface rougher. As a result of such effects, it would not have been obvious to one having ordinary skill in the art to make any of the cubes of McClintock longer or wider than any of the other cubes.

The disclosure of Scheiwiler of large paving stones that are set in place individually by hand does not provide a teaching that is applicable to the cubes of McClintock that are handled in bulk - dumped, spread, and raked together.

However, the Examiner does not concur.

Nothing in the claims are directed to any specific method steps involved in placing the claimed paving stones on a ground or surface. Hence, any argument that is not drawn to actual claim language is not persuasive. Specifically claims 3 and 16 only require a set of molded blocks a first block being that of claim 14 and other paving blocks to be oblong in shape, or in case of claims 4, 17 a square block having the size of 4 claim 14 paving blocks. Hence, any argument to how McClintock disposes the paving stones on the roadway is irrelevant to the claimed invention.

Therefore, the argument is not persuasive and the rejection is maintained.

Finally Appellant argues "The fact that a modification can be made does not mean that it would have been obvious to make the modification. The Examiner states that the set of paving stones of Scheiwiller '498 can be combined in various patterns to form an appealing surface. However, such patterns would not result, even if the different shapes disclosed in Scheiwiller '498 were used on the small stones of McClintock. The handling of the small stones in bulk - dumping, spreading, and raking together of the small stones which is an essential characteristic of the McClintock reference, would not have resulted in any specific patterns even if some stones of different shapes or sizes were included. The positions of the stones of different sizes or shapes in the pavement as a whole would be haphazard.

However, the Examiner does not concur.

There are no method claims pending in the case, hence any methods disclosed by the prior art, are not germane to the paving block or set thereof, as claimed.

Further, Rinninger clearly motivates one of ordinary skill to provide beveled edges to paving stones to enhance surface water drainage, in a manner, such as clothodial bevels, that will not cause a tripping hazard to pedestrians, as clearly disclosed by McClintock.

Therefore, the arguments are not persuasive and the rejection is maintained.

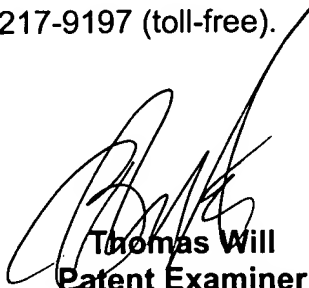
Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bartlechner # 4,761,095 discloses a bevel edged paving stone.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond W. Addie whose telephone number is 703 305-0135. The examiner can normally be reached on 8-2PM, 6-8PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 703 308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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11/27/04